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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FABIO CASATI and
MING-CHIEN SHAN

Appeal 2009-006257
Application 10/032,363
Technology Center 3600

Decided: March 12, 2010

Before HUBERT C. LORIN, FRANCISCO C. PRATS, and
BIBHU MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Fabio Casati et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-23. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM and enter a new grounds of rejection pursuant to 37 C.F.R. 41.50(b). [1]

THE INVENTION

This invention is a method and system for performing a c-service which is tailored to the specific user and their location. Specification 4:2-6.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A method for performing a context-dependent service comprising:
>
> executing a composite service;
>
> utilizing a context repository to store context information for a user, wherein said context information is automatically detected without requiring user interaction and wherein said context information is based on a present user location;
>
> accessing context information; and
>
> automatically incorporating said context

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[1] Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Mar. 4, 2008) and the Examiner's Answer ("Answer," mailed May 28, 2008).

information with said composite service.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ramanathan	US 6,182,136 B1	Jan. 30, 2001
Stewart	US 2002/0161688 A1	Oct. 31, 2002

Fabio Casati, Ski Ilnicki, Li-Jie Jin, Vasudev Krishnamoorthy, Ming-Chien Shan, *eFlow:a Platform for Developing and Managing Composite e-Services,* HP Laboratories, March 2000. [Hereinafter, Casati.]

The following rejections are before us for review:

1. Claims 1-5, 7, 8, 10-14, 16-21, and 23 are rejected under 35 U.S.C. §102(b) as being anticipated by Casati.
2. Claims 6, 15, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Casati and Stewart.
3. Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Casati and Ramanathan.

ARGUMENT

The Appellants and the Examiner dispute whether the paragraph labeled 27, on page 345 of Casati describes that the context information is automatically detected without requiring user interaction. *See* Br. 9-11 and Answer 8. The Examiner equates this claim limitation to Casati's "dynamic process evolution, wherein for example, the user has booked a flight with an air carrier hit by a strike and eFlow automatically detects the airline strike, i.e., context information, and defines a new process." Answer 4.

The Appellants respond that Casati does not teach automatically detecting the strike itself. Br. 10-11.

ISSUE

The issue is whether claims 1-5, 7, 8, 10-14, 16-21, and 23 under 35 U.S.C. §102(b) are anticipated by Casati. Specifically, the issue is whether Casati describes that the context information is automatically detected without requiring user interaction. The rejections of claims 6, 9, 15 and 22 will also turn on this issue.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Casati describes a composite service called *eMove* that supports customers in relocating. Casati pg. 341, par. 4.
2. On page 345, in paragraph 27, Casati states:

> *Dynamic process evolution: eFlow* allows service designers to modify service process definitions and to apply the changes to a subset of (or to all) the running instances of that service. In addition, the service designer may specify that newly started services should follow the new definition. For instance, consider the situation in which a strike hit a big airline company and is assumed to last for a long period: clearly, it is not practically feasible to separately modify each process instance; instead, with *eFlow*, the service designer can define a new process and specify that all running instances with a given property (in this case, all instances in which the customer has booked a flight with the

> air carrier hit by the strike) should be migrated to the new version.
> The definition of service instances that need to be migrated is performed through a very simple migration language, consisting of a set of rules of the form IF <condition> THEN MIGRATE TO <version>. The condition is a predicate over service process data and service process execution state that identifies a subset of the running instances, while <version> denotes the process definition version to which instances should be migrated. The set of rules must define a partitioning over the set of active instances, so that each instance is migrated to one version at most. An example of migration rule is: IF (selectedAirlines = "Flying High" and travelStatuts = "booked") THEN MIGRATE TO "A.00.02." Casati 345.

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

> Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences

between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham,* 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-5, 7, 8, 10-14, 16-21, and 23 under §102(b) as being anticipated by Casati.

The Appellants argue claims 1-5, 7, 8, 10-14, 16-21, and 23 as a group. Br. 9-11. We select claim 1 as the representative claim for this group, and the remaining claims 2-5, 7, 8, 10-14, 16-21, and 23 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

Claim 1 recites "wherein said context information is automatically detected without requiring user interaction." We note that claim 1 is silent as to what the context information is being detected from, and does not preclude the claimed "detecting" from being detecting the presence of the context information in a set of data.

Casati's describes an example where an airline, named "FlyHigh," is experiencing a strike and processes need to be modified so that flights are rebooked. *See* FF 2. The name "FlyHigh" can be considered the claimed user context information, since it is the airline that pertains to the user. Casati "detects" the presence of the name "FlyHigh" in the running instances

using a migration rule; for example, if "selectedAirlines" in the data equals "FlyHigh." *Id.* The migration rule is part of a newly defined process (*id.*), which can be considered to be performing the detection automatically without requiring user interaction.

As Casati states, the service designer does not manually go through all of the running instances to find the instances where "selectedAirlines" equals "FlyHigh," as this would not be "practically feasible." *Id.* Rather, the migration rule put into place by the designer automatically detects the user's airline information. Thus, the detection is automatic, by way of the migration rule, despite the fact that the service designer set the migration rule.

We find that the Appellants have not overcome the prima facie case of anticipation. Accordingly, we sustain the rejection of claims 1-5, 7, 8, 10-14, 16-21, and 23 under §102(b) as being anticipated by Casati.

The rejection of claims 6, 15, and 22 under §103(a) as being unpatentable over Casati and Stewart.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 6, 15, and 22 as being unpatentable over Casati and Stewart since the Appellants have not made any arguments beyond those previously discussed with regard to the Casati reference, thereby allowing claims 6, 15, and 22 to stand or fall with their parent claim. *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

The rejection of claim 9 under §103(a) as being unpatentable over Casati and Ramanathan.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 9 as being unpatentable over Casati and Ramanathan since the Appellants have not made any arguments beyond those previously discussed with regard to the Casati reference, thereby allowing claim 9 to stand or fall with its parent claim. *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b) (2009), we enter a new ground of rejection on claims 17-23. Claims 17-23 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Taking claim 17 as representative, claim 17 recites "[a] computer-usable medium having a computer-readable program code embodied therein." We note that the Specification is silent as the meaning of "computer-usable medium." Giving claim 17 the broadest reasonable construction, we find that claim 17 encompasses forms of the computer program code being embodied on transitory propagating signals *per se*.[2] A signal does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. §101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

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[2] *See* U.S. Patent & Trademark Office, Subject Matter Eligibility of Computer Readable Media, Jan. 26, 2010, available at http://www.uspto.gov/patents/law/notices/101_crm_20100127.pdf.

Accordingly, we reject claims 17-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

CONCLUSIONS OF LAW

We conclude that the Appellants have not over come the prima facie showing of anticipation in the rejections of claims 1-5, 7, 8, 10-14, 16-21, and 23 under 35 U.S.C. §102(b) as being anticipated by Casati and the Appellants have not over come the prima facie showing of obviousness in the rejection of:

claims 6, 15, and 22 under 35 U.S.C. §103(a) as unpatentable over Casati and Stewart; and

claim 9 under 35 U.S.C. §103(a) as unpatentable over Casati and Ramanathan.

We enter a new ground of rejection on claims 17-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The decision of the Examiner to reject claims 1-23 is affirmed. We enter a new ground of rejection on claims 17-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> • (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> • (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

AFFIRMED; 37 C.F.R. § 41.50(b)

mev

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